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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,468	06/23/2003	Alex J. Draughon	03292.101700.	7233

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EXAMINER	
PICH, PONNOREAY	
ART UNIT	PAPER NUMBER
2435	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/601,468	DRAUGHON ET AL.	
	Examiner	Art Unit	
	PONNOREAY PICH	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-7 and 9-19 are pending.

Information Disclosure Statement

The IDS submitted on 6/22/09 was considered.

Response to Amendment and Arguments

Applicant's amendments were fully considered. Any new objections or rejections made below are in response to the amendments.

Applicant's arguments were also fully considered, but are not persuasive. Applicant argues that in Janacek does not teach searching messages stored in a common storage area of a database to find messages for a first intended recipient by matching a first identifier with a message associated with the first identifier. The examiner respectfully disagrees. Figure 1 of Janacek shows a database storage system 13, which contains a message database, which is used to store all the messages in Janacek's invention (col 12, line 64), thus the message database of Janacek is equivalent to the claimed common storage area. Column 6, lines 15-18 and 27-31 discusses how messages in the message database are searched by a recipient's email address, looking for messages having a recipient's email address matching the address being used to perform the search, i.e. first identifier. This pre-processing or pre-searching of messages stored in a common storage area of the database allows all the messages addressed to a particular user to then be placed into a particular user's mailbox.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9 recites "storing a private message and a non-private message in a common storage area of a secure database system together with all other messages stored in the secure database store system...". While the application as originally filed appears to have support for storing all messages sent to a user in a common storage area (paragraph 23), there does not appear to be support for a distinction of what is a private message and a non-private message wherein both these types of messages are stored in a common storage area of a secure database system. The messages in discussed in applicant's disclosure as originally filed all required the user to authenticate in order to access the messages, thus it was assumed that all these messages were considered "private" messages. If requiring authentication is not the criteria for determining what is a private message, then applicant has not sufficiently described in the application as originally filed what criteria are used to determine what is a private message as opposed to a non-private message and the limitation discussed above does not have written description support.

Claims 10-19 are rejected due to dependency.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites a “non-private message”, which is not defined in the specification as originally filed. The messages discussed in the specification as originally filed all appear to be “private” because they all require the user to be authenticated to access the messages (paragraph 23). It is unclear what criteria are utilized by applicant to determine what makes a message "non-private" as opposed to "private" if it is not requirement for authentication to access the message. The metes and bounds of the claim cannot be determined.

Claims 10-19 are rejected either due to dependency or because they too refer to a "non-private message".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-7, 9-10, 12-14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janacek et al (US 6,684,248) in view of Poplawski et al (US 2003/0208441)

Claim 1:

Janacek discloses:

1. Storing a message in a common storage area (i.e. col 12, line 65 and Figure 1, message database) of the database storage system (i.e. Figure 1, encrypted database 13) together with all other messages stored in the database, such that all messages are stored in the common storage area (Fig 1, database 13; col 3, line 66-col 4, line 2; col 4, line 26-29; col 6, lines 5-9; col 8, lines 42-51; and col 12, line 59-col 13, line 67).
2. Associating the message with a first intended recipient by a first identifier (i.e. NuID or email address of the recipient as identified by the toEmail field in the table seen in column 13), and further associating the message with at least a second intended recipient (col 4, line 48-col 5, line 6; col 7, lines 15-17; col 8, lines 15-17; and col 13, lines 35-41—toEmail, ccEmail, and bccEmail).
3. Notifying the first intended recipient of the message stored in the database storage system using a notification message (i.e. email message) generated by the processing device, wherein the notification message contains an address of

or a link to a website, by transmitting the notification message to the first intended recipient (col 5, lines 7-12; col 8, lines 64-67; and col 10, lines 1-5).

4. Providing the website for the first intended recipient to view the message (col 5, lines 13-36).
5. Authenticating the first intended recipient using a second identifier associated with the intended recipient (col 5, lines 13-36; col 8, lines 3-17; and col 11, lines 20-24).
6. Searching the messages stored in the common storage area of the database storage system to find the messages for the first intended recipient by matching the first identifier with a message associated with the first identifier (col 6, lines 15-18 and 27-31; col 7, lines 22-64; col 8, lines 15-17; and col 10, lines 62-67). *Messages that have not yet been processed are pre-processed by searching the messages for any messages having an email address which matches a particular recipient's email address.*
7. Providing the message to the first intended recipient for display by the first intended recipient (col 5, lines 33-36).

Janacek does not disclose wherein if there is no second identifier associated with the first intended recipient, the first intended recipient is prompted to create or register a second identifier. However, Poplawski discloses of a message alert system in which if there is no second identifier (i.e. username and password) associated with the first

intended recipient, the first intended recipient is prompted to create or register a second identifier (paragraphs 29 and 38-40; and Fig 5).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Janacek's invention such that rather than automatically creating a second identifier for the first intended recipient if there is no second identifier associated with the first intended recipient, Janacek's invention instead prompted the first intended recipient to create or register a second identifier. It would have been obvious to do so because replacing the mechanism in which the second identifier is created in Janacek's invention using the one used by Poplawski's invention is simple substitution of one known element for another to obtain predictable results. Both mechanisms accomplish the same end result of creating a second identifier.

Claim 9:

Janacek discloses:

1. Storing a private message and a non-private message in a common storage area (i.e. col 12, line 65 and Figure 1, message database) of a secure database storage system (i.e. Figure 1, encrypted database 13) together with all other messages stored in the secure database storage system, such that all messages are stored in the common storage area (Fig 1, database 13; col 3, line 66-col 4, line 2; col 4, line 26-29; col 6, lines 5-9; col 8, lines 42-51; and col 12, line 59-col 13, line 67). *It is unclear what criteria are used by applicant to determine what makes a message private or non-private. However, in one interpretation, a message could be considered private if it is sent only to a single user whereas it*

is non-private if it is sent to multiple users. Note that the message database, i.e. CMMSg Database discussed in cited columns 12-13, is capable of holding messages that are addressed to a recipient identified by the toEmail field and messages that were also sent to other users identified by the ccEmail and bccEmail fields. This message database is used to store all messages. One skilled should appreciate that email messages could be sent to a single user or multiple users, thus since Janacek's message database is capable of keeping track of both types of messages, and his message database is used to store all messages, his message database is used to store both private and non-private emails, i.e. emails sent to a single user and multiple users, in a common storage area.

2. Associating the private message and the non-private message with a first identifier (i.e. NuID and/or email address of the recipient as identified by the toEmail field in the table seen in column 13) corresponding to a first intended customer recipient, wherein the first identifier includes an account number, and further associating the non-private message with at least a second intended customer recipient (col 4, line 48-col 5, line 6; col 7, lines 15-17; col 8, lines 15-17; and col 13, lines 35-41—toEmail, ccEmail, and bccEmail).
3. Notifying the first intended customer recipient of the private message stored in the secure database storage system by an electronic mail generated by the processing device, wherein the electronic mail contains an address of or a link to

a website, by transmitting the electronic mail to the first intended customer recipient (col 5, lines 7-12; col 8, lines 64-67; and col 10, lines 1-5).

4. Providing the secure website for the first intended customer recipient to view the private message (col 5, lines 13-36).
5. Authenticating the first intended customer recipient using a second identifier associated with the first intended customer recipient (col 5, lines 13-36; col 8, lines 3-17; and col 11, lines 20-24).
6. Searching the messages stored in the common storage area of the secure database storage system for the first identifier to find the private message associated with the first identifier to be viewed by the first intended customer recipient (col 6, lines 15-18 and 27-31; col 7, lines 22-64; col 8, lines 15-17; and col 10, lines 62-67). *Messages that have not yet been processed are pre-processed by searching the messages for any messages having an email address which matches a particular recipient's email address.*
7. Providing the private message associated with the first intended customer recipient to the first intended customer recipient (col 5, lines 33-36).

Janacek does not disclose wherein if there is no second identifier associated with the first intended customer recipient, the first intended customer recipient is prompted to create or register a second identifier. However, Poplawski discloses of a message alert system in which if there is no second identifier (i.e. username and password) associated

with the first intended customer recipient, the first intended customer recipient is prompted to create or register a second identifier (paragraphs 29 and 38-40; and Fig 5).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Janacek's invention such that rather than automatically creating a second identifier for the first intended customer recipient if there is no second identifier associated with the first intended customer recipient, Janacek's invention instead prompted the first intended customer recipient to create or register a second identifier. It would have been obvious to do so because replacing the mechanism in which the second identifier is created in Janacek's invention using the one used by Poplawski's invention is simple substitution of one known element for another to obtain predictable results. Both mechanisms accomplish the same end result of creating a second identifier.

Claim 2:

Janacek further discloses wherein the first identifier is an account number (col 4, line 61-col 5, line 1 and col 10, lines 62-67).

Claim 3:

Janacek further discloses wherein the second identifier is a combination of a user identification and a password (col 5, lines 13-36; col 8, lines 3-17; and col 11, lines 20-24).

Claims 5 and 12:

Janacek further discloses wherein the message includes a message portion; and an attachment file in a format that is different from a format of the message portion (col 4, lines 48-56).

Claims 6 and 13:

Janacek further discloses a step of encrypting the website to view messages using an encryption method (col 8, lines 23-27). SSL uses encryption.

Claims 7 and 14:

Janacek further discloses wherein the encryption method is SSL (col 8, lines 23-27).

Claim 10:

Janacek further discloses wherein the private message includes at least one of customer account information, a financial statement, a special offer, a response to an inquiry, and a transaction confirmation (col 4, lines 48-53; col 8, lines 64-67; and col 10, lines 7-16).

Claims 15 and 18:

Janacek and Poplawski disclose all the limitations of claims 1 and 9. Poplawski further disclose providing a second address of or link to a secure webpage on the secure website, the secure webpage containing the message, after successfully authenticating the intended recipient (paragraphs 10, 29, 44, and 46).

Claim 17:

Janacek further discloses wherein the second identifier is at least one of a user identification, an email address, and a password (col 5, lines 13-36; col 8, lines 3-17; and col 11, lines 20-24).

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janacek et al (US 6,684,248) in view of Poplawski et al (US 2003/0208441) in further view of Fung et al (US 2002/0055909).

Claims 4 and 11:

Janacek does not explicitly disclose wherein the second identifier is/includes a physical characteristic of the first intended (customer) recipient identifiable by a biometric identification system. However, Fung discloses use of an identifier that is a physical characteristic of the user that is identifiable by a biometric identification system (paragraphs 148-149).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Janacek's invention such that after a user is authenticated via a password as the second identifier the first time, a biometric identification system was used in place of the password as part of the second identifier as per Fung's teachings according to the limitations further recited in claims 4 and 11. One skilled would have been motivated to do so because a biometric identifier is more secure than a password since it cannot be forgotten by the user.

Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janacek et al (US 6,684,248) in view of Poplawski et al (US 2003/0208441) in further view of Choubey et al (US 7,305,430).

Claims 16 and 19:

Janacek and Poplawski disclose all the limitations of claims 1 and 9. Janacek does not explicitly disclose wherein if a particular message/the message has multiple intended (customer) recipients, a separate copy of the (particular) message is not stored in the database for each intended (customer) recipient. However, Choubey discloses the limitation (col 1, lines 55-61).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify Janacek's invention such that if the (particular) message has multiple intended (customer) recipients, a separate copy of the particular message is not stored in the database for each intended (customer) recipient as per Choubey's teachings. One skilled would have been motivated to do so because it would reduce data storage requirements associated with the email message (Choubey: col 1, lines 57-61).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PONNOREAY PICH whose telephone number is (571)272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/
Primary Examiner, Art Unit 2435